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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,248	09/29/2003	Paulo S. Tubel	014-12049-D3	3193

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EXAMINER

TSAY, FRANK

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/674,248

Applicant(s)

TUBEL ET AL.

Examiner

Frank S Tsay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-29 and 61-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19, 61, 62, 74-76, 79 and 80 is/are rejected.
- 7) ☒ Claim(s) 21, 24, 63-73, 77, 78 and 81-94 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

Claims 1-15, 20, and 22-60 have been canceled. The claims now pending in the application are claims 16-19, 21, and 61-94.

***Double Patenting***

Prior rejection of claims under the judicially created doctrine of obviousness-type double patenting has been withdrawn in view of new grounds for rejections as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 16 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller (US 5,176,207).

The first well is met by well 12, the at least one downhole fiber optic sensor is met by col. 4, lines 47-60, where instrument such as fiber optic sensor is used to measure at least one parameter associated with injecting fluid into the well (see abstract lines 12+). The claimed “wherein said first well is selected from (I) an injection well, and (II) a production well” is anticipated by the teachings including in the abstract, “Typical measurement include....pore fluid extraction and injection....., and the like; col. 1, lines 18+, “oil and gas production”; col. 4, lines 36+, “tube is used to inject a material”; col. 5, lines 63+, “insitu sampling of geological effluent or of injecting a grout”, which can only be applied to either a producing well or an injection well.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19, 61, 62, 75, 76, 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller '207 in view of Kluth (US5,804,713).

Keller teaches everything except the electronic controller. Kluth reference is used simply to show that the use of electronic controller in fiber optic sensing is a well know art and also an obvious engineering expedient, it would therefore have been obvious to one of the ordinary skill in the art at the time the invention was made to have incorporated an electronic controller either on the surface or downhole to control the fiber optic sensing device since such would have been an obvious design option. The installation of fiber optic sensor in a second well is considered a simple matter of engineering decision to one of the ordinary skill in the art, since there is no specific reason why the same can not be installed in a second well similar to that of the first well.

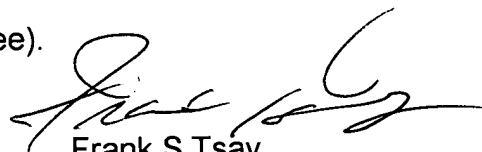
***Allowable Subject Matter***

Claims 21, 24, 63-73, 77, 78, and 81-94 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank S Tsay whose telephone number is (703) 308-2170. The examiner can normally be reached on Monday thru Friday, 7:30am-5:00 pm, 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on (703)308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frank S Tsay  
Primary Examiner  
Art Unit 3672

5/7/05